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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,043	06/15/2001	Guenter Jokschas	178/50052	5173

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EXAMINER
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OCAMPO, MARIANNE S

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/881,043

### Applicant(s)

JOKSCHAS ET AL.

### Examiner

Marianne S. Ocampo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,8-10 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,8-10 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1-5-04 has been entered.

### ***Withdrawal of Previously Indicated Allowability of Claims***

2. The indicated allowability of claims 1 and 8 – 9 is withdrawn in view of the newly discovered references to Davidson (US 5,591,329), Richardson (US 5,213,682) and Weber (US 4,610,848). Rejections based on these newly cited references are set forth below.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 10 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The independent claim 10 contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. In particular, the newly added limitation “the lateral recess is arranged radially outside of the annular filter medium”, lacks enough support from the original disclosure and contrary to applicants’ assertion, Figure 2 of the original drawings does not support this limitation of the lateral recess being *radially* outside the filter medium. In fact, in both Figures 1 & 2, showing cross-sections of the filter, the lateral recess is within the radius of the annular filter medium (i.e. radially inside the filter medium), and not on the outer peripheries/outside the radius of the annular filter medium (i.e. radially outside the filter medium). Furthermore, the disclosure in page 7, lines 1 – 6, mentions the lateral recess (23) being formed by a folded pocket of the filter medium, and it is considered that the term “pocket” implies the recess is within the boundaries of the filter medium. Claim 13 suffers the same defects of claim 10, since it depends therefrom.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Davidson (US 5,591, 329).

7. Concerning claim 10, Davidson discloses a filter cartridge comprising an annularly constructed filter medium (72, 50) arranged between two axial end plates (68 & 70), wherein the filter medium (72) is provided with at least one lateral recess (defined by one of those outer pleat spacings or pleat spacings on the outer periphery of the filter medium) capable of accommodating a functional part in which the filter cartridge is to be installed, wherein the filter medium (72) is a pleated filter sheet (i.e. netting/septum of polypropylene or other flexible woven fabric or screen), and the (at least one) lateral recess comprising a pocket formed by an enlarged spacing between two adjacent pleats (98, as in fig. 10) and the two axial end plates (68 & 70) being provided with notches (defined by holes 96, as in figs. 4 & 10) aligned with the lateral recess in the filter medium so that a functional part can be inserted in an axial direction through one of the end plates into the lateral recess in the filter medium, and the lateral recess

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being arranged outside of the filter medium, as in figs. 4 & 10 and cols. 4 – 8. Note that in this rejection, the examiner has defined the location of the lateral recess of “radially outside” in accordance to applicants’ definition/argument found in pages 5 – 6 of the remarks filed on 1-5-04, that is the lateral recess is located on the outer peripheries/outside the boundary of the filter medium, **but not necessarily the lateral recess being located outside the radius** (commonly referred to as *radially outside*) of the filter medium.

8. Regarding claim 13, Davidson has disclosed the limitations of claim 10 above. Davidson further discloses the lateral recess in the filter medium extending axially from one of the end plates (68 or 70) to the other end plate (70 or 68, respectively), as in fig. 4.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1 and 8 – 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson (US 5,213,682) in view of Davidson (US 5,591,329) and Weber (US 4,610,848).

11. Concerning claim 1, Richardson discloses a filter comprising:

- a filter housing (7) with an inlet (2, 12) and an outlet (3, 9) for a fluid to be filtered;
- a filter cartridge (10) arranged in the housing so that fluid from the inlet (2, 12) must flow through the cartridge (10) to reach the outlet (9, 3) and
- an additional functional part (16, 19, 20), and wherein the filter cartridge comprising an annularly constructed filter medium arranged between two axial end plates, and the filter medium (10) being provided with a recess (a central one) for accommodating the additional functional part (16, 19, 20) of the filter (7), the additional functional part comprising a probe of a water level sensor, and the filter medium (10) comprising a sheet of filter (paper) material, and the recess in the filter medium of the cartridge extending axially at least to one of the end plates (i.e. top end plate) wherein the one (top end plate) end plate being provided a notch (opening) aligned with the (central) recess in the filter medium, as in figs. 1 – 4 and cols. 1 – 3.

Richardson fails to disclose the filter material of the filter medium being folded in a zigzag fashion to form a pleated structure, and the recess being a lateral recess and is a folded pocket formed by an enlarged distance between adjacent folds.

12. Davidson teaches a filter (10) similar to that of Richardson, the filter of Davidson comprising a filter housing (12, 14) with an inlet (26) and an outlet (28) for a fluid to be filtered, and a filter cartridge (50) arranged in the housing so that fluid from the inlet (26) must flow through the cartridge (50) to reach the outlet (28) wherein the wherein the filter cartridge (50) comprising an annularly constructed filter medium (72) arranged between two axial end plates

(68 & 70), and the filter medium (72) being provided with at least one lateral recess capable of accommodating an additional functional part (such as a probe of a water level sensor) and the recess being a folded pocket formed by an enlarged distance (formed on the outer periphery of the filter medium 72) between adjacent folds (pleats 98) and the filter medium (72) comprising a sheet of filter material folded in zigzag fashion to form a pleated structure, and the (at least one) lateral recess in the filter medium (72) of the cartridge extending axially at least to one of the end plates (68 or 70) wherein the one end plate being provided at least one notch (96) aligned with the (at least one) lateral recess in the filter medium (72), as in figs. 4 & 10 and cols. 4 – 8.

It is considered obvious to one of ordinary skill in the art at the time of the invention to modify the filter of Richardson by adding the embodiment taught by Davidson, in order to provide an alternative configuration/shape (i.e. pleated structure) for the filter medium of the cartridge of Richardson which allows greater surface area for filtering, and furthermore, provide an alternative design and location for positioning an additional part (such as a probe of a water sensor), thereby providing a greater opening for filtered fluid to flow out of the filter and as a mere design choice of the user. It has been known in the art to place a probe of a water sensor in lateral portions/sides of filters/filter housing, as evidenced and shown in figs. 2 – 4 by Weber (US 4,610,848).

13. With respect to claim 8, Richardson, as modified by Davidson and Weber, has taught the limitations of claim 1 above. Richardson further discloses the housing comprising a housing cup (body, 7) and a housing cover (head unit, 1) and the functional part (16, 19, 20) being



mounted on the cover (1) and extending into the recess in the filter medium of the cartridge when the cartridge is installed in the housing. In combination with Davidson and Weber, the resulting product would have a lateral recess to accommodate the additional functional part (as in figs. 2 – 4 of Weber), and therefore, the cover of the resulting product based on the combination of teachings of Richardson, Davidson and Weber, would have a lateral recess (such as the one in the cover 40, 60 of Weber) to mount the additional functional part therein.

14. Concerning claim 9, Richardson, as modified by Davidson and Weber, has taught the limitations of claim 1 above. Richardson also discloses the filter being a fuel filter for an (internal combustion) engine, as in col. 1.

### ***Response to Amendments and Arguments***

15. Applicant's amendments and arguments with respect to claims 10 and 13 have been considered but are moot in view of the new grounds of rejection set forth above. Furthermore, claims 1 and 8 – 9 which have been previously indicated allowable, are now also rejected based on the newly found prior art presented above.

16. **This action is non-final.**

***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patents 6,514,404 B1 (Bauer), 4,638,305 (Sutton), 3,749,247 (Rohde), 5,900,140 (Nagai et al.), 5,900,148 (Izutani et al.) and 5,904,845 (Girondi).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne S. Ocampo whose telephone number is (571) 272-1144. The examiner can normally be reached on Mondays to Fridays from 8:30 A.M. to 4:30 P.M..

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (571) 272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.S.O.

  
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